

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05-364

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on _____

Signature _____

Typed or printed name _____

Application Number

10/537,365

Filed

June 2, 2005

First Named Inventor

Dieter Goldbach et al.

Art Unit

3657

Examiner

J. K. Hsiao

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Gregory P. LaPointe #28395/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Gregory P. LaPointe

Typed or printed name

☒ attorney or agent of record.
Registration number 28,395

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Telephone number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

January 7, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 11.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Applicants respectfully request the Examiner to reconsider his final rejection for the reasons set forth hereinbelow.

On Page 3 of the Examiner's Final Rejection, specifically the paragraph bridging pages 3 and 4, the Examiner sets forth the following:

"Applicant's arguments with respect to claims 39-51 have been considered but they are not persuasive. Regarding the argument that the combination of the references would destroy the purpose of the primary reference, the rejection does not rely on the primary reference for the purpose of that reference. The rejection relies on the structure for purposes of examination."

The Examiner's position is untenable and flies in the face of established case law. It is clearly established in the case law that references are not properly combinable or modifiable if their intended function is destroyed. "A §103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the *reference*, is not proper and the prima facie case of obviousness cannot be properly made. In short, there would be *no technological motivation* for engaging in the modification or change. To the contrary, there would be a disincentive. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The Federal Circuit observed in *Gordon* that if the prior art filter-separator were physically inverted, as would be necessary to meet claim limitation, the reference filter would become impenetrable and fluid would be trapped rather than separated."

The Examiner's position as set forth in his rejection and his response to Applicants' previously submitted arguments fly in the

face of the established case law set forth by The Federal Circuit. The Examiner's rejection is improper as the references cannot be properly combined in light of the fact that the modification as proposed by the Examiner would destroy the intended function of the primary reference.

In light of the foregoing, it is submitted that the Examiner should withdraw his rejection and issue a formal notice of allowance.